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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,795	12/08/2005	Masakatsu Nitawaki	107348-00543	7495
4372	7590	10/16/2008		
ARENT FOX LLP 1050 CONNECTICUT AVENUE, N.W. SUITE 400 WASHINGTON, DC 20036			EXAMINER LUGO, CARLOS	
			ART UNIT 3673	PAPER NUMBER
			NOTIFICATION DATE 10/16/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com
IPMatters@arentfox.com
Patent_Mail@arentfox.com

Office Action Summary

Application No.

10/559,795

Applicant(s)

NITAWAKI ET AL.

Examiner

CARLOS LUGO

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 July 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to applicant's amendment filed on July 15, 2008.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. **Claim 1 is rejected** on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,217,899. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Claim 1 of the instant application requires a handle having electrodes and a circuit board to detect change in capacitance. These limitations are presented in claim 1 of the '899 patent.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-6 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,075,294 to Van den Boom et al (Van den Boom) in view of US Pat No 5,304,967 to Hayashi.

Regarding claim 1, Van den Boom discloses a vehicle door outer handle system comprising an operating handle (13) comprising a handle main body made of a synthetic resin and a cover (29) made of a synthetic resin so as to cover the outer side of the handle main body (28).

The operating handle is disposed on an outer side of a vehicle door. A pair of electrodes (30); and a circuit board (34), on which is provided a detection circuit for detecting a change in capacitance between the electrodes, are housed within the operating handle.

However, Van den Boom fails to positively disclose that the electrodes are patterned on the circuit board.

Hayashi teaches that it is well known in the art to provide a circuit board (43) having electrodes (52-56) patterned on it (Col. 8 Lines 1-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the electrodes described by Van den Boom patterned on the circuit board, as taught by Hayashi, in order to organize all the circuit components in a single component.

As to claim 2, Van den Boom, as modified by Hayashi, illustrates that among opposite faces of the circuit board (34), a component of the detection circuit is mounted on the face on the side opposite to the face where the electrodes are patterned.

As to claims 3/1 and 3/2, Van den Boom, as modified by Hayashi, illustrates that among opposite faces of the circuit board, the electrodes are capable of being patterned on the face on the vehicle side.

As to claim 4, Van den Boom illustrates that a sensor unit, which comprises the electrodes, the circuit board, and a covering portion made of a synthetic resin and

covering the electrodes and the circuit board, is fixedly housed in a housing recess formed in the handle main body so as to open on the cover side.

As to claim 5, Van den Boom illustrates that the electrodes (30) and the circuit board (34) are mounted on a holder (surface of 28 in contact with the sensor unit), a majority of the holder is covered by the covering portion so as to form a part of the sensor unit.

As to claim 6, Van den Boom illustrates that a ground plate (36) forming a part of the sensor unit is mounted on the holder so as to cover the electrodes and is covered by the covering portion (29).

6. **Claims 1-6 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,883,840 to Sueyoshi et al (Sueyoshi) in view of US Pat No 6,075,294 to Van den Boom et al (Van den Boom) and in view of US Pat No 5,304,967 to Hayashi.

Regarding claim 1, Sueyoshi discloses a vehicle door outer handle system comprising an operating handle (7) comprising a handle main body made of a synthetic resin. The operating handle is disposed on an outer side of a vehicle door and includes an electrode (21) inside the main body.

Sueyoshi fails to disclose a pair of electrodes. However, applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art.

Also, Sueyoshi fails to positively disclose that the handle is comprised of a main handle body and a cover.

Van den Boom teaches that it is well known in the art to provide a handle composed of separate members connected together, specifically, having a cover part (29) and a main body (28).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the handle described by Sueyoshi as a cover part and a main body, as taught by Van den Boom, in order to provide a handle in which the inner components can be easily reached by just taking out a cover.

Further, Sueyoshi fails to disclose that the electrode is "patterned" in a circuit board placed inside the handle body.

Van den Boom teaches that it is well known in the art to provide a circuit board (34) interacting with the electrodes.

Hayashi teaches that it is well known in the art to provide a circuit board (43) having electrodes (52-56) patterned on it (Col. 8 Lines 1-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the electrode described by Sueyoshi interacting with a circuit board, as taught by Van den Boom, in order to provide an electric component that would read and actuate with respect to what the electrode is sensing.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the electrode described by Sueyoshi patterned on a circuit board, as taught by Hayashi, in order to organize all the circuit components in a single component.

As to claim 2, Sueyoshi, as modified by Van den Boom and Hayashi, illustrates that among opposite faces of the circuit board, a component of the detection circuit is mounted on the face on the side opposite to the face where the electrodes are patterned.

As to claims 3/1 and 3/2, Sueyoshi, as modified by Van den Boom and Hayashi, illustrates that among opposite faces of the circuit board, the electrodes are capable of being patterned on the face on the vehicle side.

As to claim 4, Sueyoshi, as modified by Van den Boom and Hayashi, illustrates that a sensor unit, which comprises the electrodes, the circuit board, and a covering portion made of a synthetic resin and covering the electrodes and the circuit board, is fixedly housed in a housing recess formed in the handle main body so as to open on the cover side.

As to claim 5, Sueyoshi, as modified by Van den Boom and Hayashi, illustrates that the electrodes and the circuit board are mounted on a holder (surface of the handle main body in contact with the sensor unit), a majority of the holder is covered by the covering portion so as to form a part of the sensor unit.

As to claim 6, Sueyoshi, as modified by Van den Boom and Hayashi, illustrates that a ground plate (36 in Van den Boom) forming a part of the sensor unit is mounted on the holder so as to cover the electrodes and is covered by the covering portion (29 in Van den Boom).

7. **Claims 7 and 8 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,075,294 to Van den Boom et al (Van den Boom) in view of US Pat No

5,304,967 to Hayashi as applied to claims 4 and 5, and further in view of US Pat No 6,769,154 to Klein et al (Klein).

Van den Boom, as modified by Hayashi, fails to disclose the holder is a separate member that is mounted on the handle main body. Van den Boom discloses that the handle main body acts as a holder.

Klein teaches that it is well known in the art to provide a holder (15) that holds electric components (16) inside a handle main body. As to the shape of the part that holds the holder in the main handle body, the shape is considered as a design consideration within the art that has no critically. The shape of this receiving part would be according to the holder specifications and/or shape that are best for fitting the holder in the handle main body.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the handle main body described by Van den Boom, as modified by Hayashi, with a holder member, as taught by Klein, in order to hold in place the components inside the handle main body.

8. **Claims 7 and 8 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,883,840 to Sueyoshi et al (Sueyoshi) in view of US Pat No 6,075,294 to Van den Boom et al (Van den Boom) and of US Pat No 5,304,967 to Hayashi as applied to claims 4 and 5, and further in view of US Pat No 6,769,154 to Klein et al (Klein).

Sueyoshi, as modified by Van den Boom and Hayashi, fails to disclose the holder is a separate member that is mounted on the handle main body. Van den Boom teaches that the handle main body acts as a holder.

Klein teaches that it is well known in the art to provide a holder (15) that holds electric components (16) inside a handle main body. As to the shape of the part that holds the holder in the main handle body, the shape is considered as a design consideration within the art that has no criticality. The shape of this receiving part would be according to the holder specifications and/or shape that are best for fitting the holder in the handle main body.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the handle main body described by Sueyoshi, as modified by Van den Boom and Hayashi, with a holder member, as taught by Klein, in order to hold in place the components inside the handle main body.

Response to Arguments

9. Applicant's arguments filed July 15, 2008 have been fully considered but they are not persuasive.

With respect to the double patenting rejection, the arguments are not persuasive and the rejection is maintained. At the instant, both application are claimed the same general elements, therefore, an immediate terminal disclaimer is required.

Also, the applicant argues the rejection of the claims in view of Van den Boom, as modified by Hayashi. First, the applicant argues that Van den Boom comprises two electrodes 30 and 31 that are required to be separate from each other. As clearly

explained in the rejection, Van den Boom discloses that the handle has a pair of electrodes in the handle, which is element 30, as been clearly seen in figure 3. Therefore, the pair of electrodes defined by Van den Boom is required to be located in the same place. Second, the applicant argues that because Hayashi fails to disclose that the electrode does not detect the change of capacitance, it would not be obvious to have the combination. As clearly explained above, the rejection is in view of Van den Boom as modified by Hayashi. Hayashi is only used to demonstrate that it is well known in the art to provide a circuit board having electrodes patterned on it. Therefore, the arguments are not persuasive and the rejection is maintained.

As to the other arguments with respect to the rejection of the claims in view of Sueyoshi, as modified by Van den Boom and Hayashi, the applicant argues that Sueyoshi fails to disclose a pair of electrodes and the same arguments with respect to Van den Boom and Hayashi. With respect to the pair of electrodes, applicant is reminded that duplicating the components of a prior art device is a design consideration within the skill of the art. Therefore, the arguments are not persuasive and the rejection is maintained.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARLOS LUGO whose telephone number is (571)272-7058. The examiner can normally be reached on 10-7pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3673

/Carlos Lugo/
Primary Examiner
Art Unit 3673

October 10, 2008.